

REMARKS

Reconsideration of the application is respectfully requested based on the following remarks.

In the Office Action, the Examiner rejected claims 1 and 9-13, and objected to claims 2-8. Claims 1 and 10 have been amended. Claims 12 and 13 have been cancelled. Claims 14-18 have been added to expedite prosecution. As such, claims 1-18 (excluding claims 12 and 13) are currently pending.

Claims 1 and 10 have been amended to further clarify the subject matter regarded as the invention. Support for the amended claims may be found in the Specification. For example, claim 1 d was amended to clarify the nature of the inner tube “moving” as “longitudinally retracted”, which is supported, for example, by the arrows in Figure 4b and the Figure’s corresponding textual description. Claim 1 b was amended to correct the foregoing described and supported error where “outer barrel” is corrected to be “outer tube” (see paragraph 0016).

To expedite prosecution of this application, Applicant has cancelled claims 12 and 13 without prejudice or disclaimer- method claims are not sought at this time. Accordingly, these rejections are moot. Therefore, no additional comments need be provided with respect to these rejections under 35 U.S.C. § 102(b). However, it should be noted that by canceling claims 12 and 13, Applicant is not admitting agreement with the Examiner’s position or otherwise indicating or acquiescing to the unpatentability of these claims.

OBJECTION TO CLAIMS 2-8

Examiner states that claims 2-8 are objected to as depending on a rejected claim 1, but would be allowable if rewritten in independent form. Although, as set forth below,

Applicant believes claim 1 is patentably distinct over the cited prior art, and thus will request withdrawal of the objection, to expedite prosecution of this application, however, Applicant has generated new claims 13-16. Claim 13 is the same as claim 1, except it comprises the limitations of allowed claim 7, which claim 7 was not rejected by Examiner. Dependent claims 14-16 exactly correspond to allowable claims 2, 3, and 8.

REJECTION OF CLAIMS 1 AND 10 UNDER 35 USC §102(b)

In the Office Action, the Examiner rejected claims 1, 10, 12, and 13 under 35 USC §102(b) as being anticipated by Stocking (US 3,064,294). Applicant respectfully disagrees, and this rejection is fully traversed below.

It is noted that certain requirements of Applicant's claim 1 (as amended) set forth certain structural and functional differences from Stocking. It is further noted that Examiner was not specific about which structural elements of Applicant's rejected claims that directly correspond elements taught in Stocking. Hence, Applicant must make assumption as to what corresponding elements Examiner is asserting anticipate Applicant's rejected claims. As such, what follows below are elements presumed to be viewed by Examiner as corresponding between Stocking's teachings and Applicant's claim 1 (as amended). That is, it is presumed that Examiner is asserting that the cleaning tip compression member (for example, fastener end 117) of the instant invention corresponds to Stocking's compression member 6 of Fig. 2, and, thereby, it is further presumed Examiner is asserting that the inner tube of the present invention corresponds to Stocking's rod 23 and bushing 22 of Figs. 1 and 2 (please note that this presumption of an inner tube/outer tube configuration existing in Stocking is contested below). Even if we assume this structural correspondence, Examiner's attention is drawn to the requirement of claim 1 d (as amended), which states that:

“the cleaning tip compression member is ... actuated to induce a compression state ... in the ... compressible cleaning tip when the inner tube is longitudinally retracted relative to the outer tube”.

In contrast, Stocking teaches a compression member 6 that is retracted by rotating rod 23 (see Stocking's column 3 lines 29-36; and column 4, lines 17-25 & lines 40-45), **not** by longitudinally retracting the rod, which rod is actually incapable of being longitudinally

retracted to retract compression member 6, as is required by applicants claim 1 (as amended). Hence, Stocking clearly does not teach or suggest this limitation, and thereby, on a first count, does not anticipate Applicant's claim 1 (as amended). This clear difference between Stocking's invention and the Applicant's claim 1 brings to light that Stocking does not teach an inner tube and outer tube configuration, which operate together to compress a compressible cleaning tip, as required by Applicant's claim 1.

As such, Applicant disagrees that Stocking teaches or suggests any corresponding structural element to the inner tube of the present claim 1. Given that the present claim 1 requires that the:

“second end of the cleaning tip compression member is in communication with the first end of the inner tube”,

According to Stocking's teachings (e.g., see Stocking's Figs. 1 & 2 and column 3, lines 26-31), that would seem to imply that Stocking's rod 23 and bushing 22 are the inner tube of the present invention as claimed in claim 1, which requires that one tube (i.e., an inner tube) being configured to be inserted into another tube (i.e., an outer tube). However, in contrast to Stocking, the present claim 1 further requires that the:

“**the inner tube** is configured to permit the inner tube to be movabley inserted along the length of the outer tube”

Thus, given that Stocking's rod 23 and bushing 22 are **not** “configured to permit [rod 23 and bushing 22] to be movabley inserted along the length of [an] outer tube” (again see Stocking's Figs. 1 & 2 and column 3, lines 26-31), then Stocking clearly does not teach or suggest an outer tube, which limitation is required by Applicant's claim 1; and, hence, on a second count, Stocking does not anticipate Applicant's claim 1. Clearly, Stocking's rod 23 and bushing 22 are simply rotated to retract compression member 6 and compress Stocking's sleeve 13 (see column 3, lines 66-69) against a **washer 19** (see column 3, 13-15), no outer tube is present or needed.

Given that Stocking does not teach or suggest an outer tube and inner tube, claim 10 is not anticipated by Stocking, at least because the present claim 10 requires an outer tube:

“...wherein the **outer tube** and inner tube are made of a...”

In view of the foregoing discussion, the anticipation rejection of claims 1 and 10 are

believed overcome, and are, thereby, patently distinct over Stocking. In great anticipation of claim 10's allowance by Examiner, to expedite prosecution of this application, Applicant has generated claim 18, which rewrites claim 1 in a partial means form to include the limitations in claim 10.

REJECTION OF CLAIMS 9, 10, AND 11 UNDER 35 USC §103(a)

In the Office Action, the Examiner rejected claims 9, 10, and 11 under 35 USC §103(a) as being unpatentable over Stocking in view of Schneider (US. 4,698,932) for claims 9 and 11, and in further view of Deudeaux (US. 5,987,799) for claims 9 and 10. Claims 9, 10, and 11 all depend on claim 1, which it is submitted are also patentably distinct over any combination of Stocking, Schneider, or Deudeaux for at least the same above reasons for their base independent claim 1. The additional limitations recited in the independent claim 1 or its dependent claims do not require further discussion as the above discussed limitations are clearly sufficient to distinguish the claimed invention from any combination of Stocking, Schneider, or Deudeaux. Moreover, Examiner states that Stocking "comprises all claimed elements including inner and outer tubes..."; however, as clearly set forth above Stocking fails to disclose or suggest an inner and outer tube configuration, and, in particular has no outer tube. Thus, it is respectfully requested that the Examiner withdrawal the rejection of claims 9, 10, and 11 under 35 USC §103(a), and withdrawal the objection to claims 2-8.

Further discussion with respect to Deudeaux will be presented after it is first noted that Examiner did not use Schneider to reject claim 10, and require Deudeaux in an attempt to establish a prima facie case of obviousness under 35 USC §103(a). As implied by the fact that Schneider was not used to reject the claim 10, Schneider does not teach or suggest the limitations of Applicant's claim 10. Thus, it is submitted that claim 10 is patentably distinct from Schneider.

Applicant further notes that Deudeaux is not believed to be analogous prior-art and should not be part of the basis for establishing prima facie case of obviousness under 35 USC §103(a). It is well established in case law (examples cited below) that several factors

may illuminate the analogous art inquiry, including the type of art applied to the application in the Patent and Trademark Office (see *Armament Sys. & Procedures, Inc. v. Monadnock Lifetime Prods., Inc.*, Civ. App. 97-1174, slip op. at 13 (Fed. Cir. Aug. 7, 1998)), and that the prior-art be reasonably pertinent to the inventor's problem (see *In re Greene*, Civ. App. No. 93-1446, slip op. at 3-4 (Fed. Cir. Mar. 17, 1994)). It is moreover brought to Examiner's attention that prior-art is not in the same field of endeavor as the claimed subject matter merely because it relates to guns or the insertion of devices into barrels thereof (see *Wang Labs., Inc. v. Toshiba Corp.*, 26 USPQ 2d 1767, 1773 (Fed. Cir. 1993)). Hence, in the present case, Deudeaux is solving a completely different problem and a very different endeavor; namely the inserting or extracting a specially designed bullet into or from a firearm barrel. This endeavor bears no reasonable relation to the claims of the present invention (e.g., cleaning paint from the inside of a paint gun barrel), whereby, Applicant would not be expected to be aware of Deudeaux, and, hence should not be part of the basis for establishing prima facie case of obviousness under 35 USC §103(a). This is further evidenced by the fact that Deudeaux is under US class 42, while the present invention is preliminarily classified under US class 15, which is presumed to be the principle classification that one would be expected to search.

Although Applicant contends that Deudeaux is not analogous prior-art, it is should noted that original claim 10 requires that:

“the outer tube and inner tube are made of a malleable material that may be cut to an arbitrary length using common cutting tools”

It is, of course, the presumption that “may be cut to an arbitrary length” implies “and remain operable for their intended purpose”. Given that Examiner did not reject claim 10 under 35 USC §112 for not distinctly claiming subject matter it is presumed that Examiner agrees. However, for the sake of clarity, claim 10 was amended to include this “operable for their intended purpose” limitation. Applicant would like to bring to Examiner's attention that in contrast to Applicant's invention as claimed, in Deudeaux, if plunger rod 20 and hollow shaft 12 were cut to an arbitrary length, these components, and thus Deudeaux's invention, would clearly not remain operable for their intended purpose. It is noted that a similar argument applies against Stocking and Schneider. Thus, neither Stocking or Deudeaux (or Schneider for that matter), alone or in any combination, teach or suggest that an “outer tube and inner tube are made of a malleable material that may be **cut to an arbitrary length**”, as required by claim 10. Moreover, as set forth above in the 102

response section, **Stocking does not teach** or suggest an outer tube and inner tube. Examiner's attention is further drawn to Applicant's specification in paragraph 0026, where it says "When outer tube 100 and inner tube 105 are made from sufficiently soft and malleable plastic, an attendant capability of the present invention is to enable the user to cut, using common cutting tools, outer tube 100 and inner tube 105 to a desired length for a particular paintball gun barrel application. Those in the art will appreciate that the user may readily determine the optimal length required for their particular application." It is noted that this capability does not exist in Stocking, Schneider, or Deudeaux, alone or in any combination. Thus, claim 10 (as amended) is patentably distinct over Stocking, Schneider, or Deudeaux, alone or in any combination, and Examiner is again respectfully requested to withdraw the rejection of claim 10.

It is further noted that in the rejection of claim 9, Examiner suggests it is obvious to "modify the tip [of Stocking] to have spherical shape." Applicant respectfully disagrees with Examiner's presumption. Stocking only teach of cylindrical cleaning tips. As Examiner is aware, when cleaning a cylindrical gun barrel, a cylindrical cleaning tip will have a higher contact (i.e., cleaning) surface area than a spherical shaped cleaning tip, thus cylindrical cleaning tips have been conventionally the cleaning tip shape of choice. Thus, the choice of a spherical shaped cleaning tip (having a lower cleaning contact surface area) is against the conventional wisdom of maximizing contact surface area. This is evidenced by the fact that an object of Stocking's invention is to "provide a ... gun cleaning device which will apply pressure to the cleaning patch evenly along **a considerable length** while within the gun barrel to thereby **increase the effective cleaning surface thereof**" (see Stocking, column 1, lines 62-68). Hence, Stocking in fact teaches away from using cleaning tips with lower cleaning contact surface areas, such as the spherical ball shaped required in Applicant's claim 9. Thus, an ordinary skilled artisan reading Stocking's teaching away from lower surface area tips would have been taught to not even contemplate a spherical ball shaped cleaning tip (as required in claim 9), as the spherical ball shape inherently has a lower cleaning contact surface area.

For at least this reasons it could not have been obvious to "modify the tip [of Stocking] to have spherical shape", as, in effect, Stocking in fact teaches away from the spherical shape. As Examiner would surely agree, references that teach away generally cannot serve to create a *prima facie* case of obviousness (see *McGinley v. Franklin Sports Inc.*, 60 USPQ 2d 1001, 1010 (Fed. Cir. 2001)). Accordingly, claim 9 is believed patentably distinct over

Stocking, Schneider, or Deudeaux, alone or in any combination, and Examiner is again respectfully requested to withdraw the rejection of claim 9.

It is further remarked that given that Stocking is very old prior-art (1962), and so is Schneider (1987), if it were obvious to modify Stocking to a spherical ball shaped cleaning tip due to its inherent desirability as Examiner asserts (“ease of production, better fit . . . , greater availability.”) then one would have expected Schneider, filed 24 years later, to have mentioned its tip could, or even should, be spherical in shape. Schneider is completely silent about a spherical tip, further cutting against obviousness thereof. Moreover, given that Examiner was not able to find any pertinent prior art more recent than Schneider (over 17 years ago) that even mentions a spherical ball shaped cleaning tip as required by claim 9, further cuts against the obviousness thereof. Furthermore, Applicant, who has been and is intently engaged in the business of paint ball gun cleaners, would like to bring to Examiner’s attention as a secondary consideration further cutting against obviousness, that, to date, no known product that has ever been on the market has ever been capable of being cut to an arbitrary length or includes a spherical ball shaped cleaner tip.

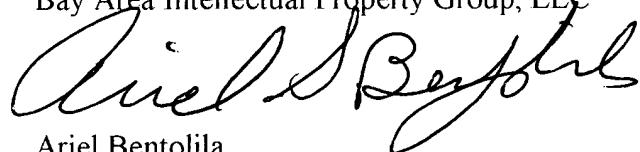
For at least the foregoing reasons, Applicant asserts that a prima facie case of obviousness under 35 USC §103(a) has not been established for claims 9, 10, or 11, and Examiner is once again respectfully requested to withdraw the rejections of claims 9, 10, and 11.

C O N C L U S I O N

In view of the forgoing, it is submitted that claims 1 (as amended), 9, 10 (as amended), and 11 are patentably distinct over Stocking, Schneider, or Deudeaux, alone or in any combination. Examiner’s reconsideration of the application and an early Notice of Allowance are earnestly solicited. If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response, an Examiner’s Amendment, or otherwise if the Examiner believes that further discussion would expedite the prosecution of this application, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case, and for any required fee for such extension or any further fee required in connection with the filing of this Amendment, the Commissioner is hereby authorized to charge any required fees, not included with this paper, and or credit any overpayment directly to the credit card indicated in the attached Credit Card Payment form PTO-2038.

Respectfully submitted,
Bay Area Intellectual Property Group, LLC



Ariel Bentolila
Registration No. 52,614

BAY AREA INTELLECTUAL PROPERTY GROUP, LLC

P.O. Box 210459
San Francisco CA, 94121-0459
Telephone (415) 515-3005